

REMARKS

Claims 1-54 were pending in this application at the time the present Office Action was mailed. Claims 24-54 have been cancelled in this response. Accordingly, claims 1-23 are now pending in the present application.

In the Office Action mailed July 3, 2002, claims 1-23 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

(A) Restriction to one of the inventions is required under 35 U.S.C. § 121; and

(B) Claims 1-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,319,108 to Adefris et al. ("108 patent") and U.S. Patent No. 6,354,929 to Adefris et al. ("929 patent").

The undersigned attorney wishes to thank the Examiner for engaging in a telephone conference on September 30, 2002 to discuss the present Office Action. The Examiner agreed that claim 1 is patentable over the applied references pending a further detailed review of the applied references.

A. Response to the Restriction Requirement

In response to the Restriction Requirement dated July 3, 2002, applicant hereby affirms the election without traverse to prosecute the invention of Group 1, claims 1-23.

B. Response to the Section 103(a) Rejection

Claims 1-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '108 patent and the '929 patent.

1. Claim 1 Is Directed to a Method for Forming a Planarizing Medium Including Drawing a Support Material and Discrete Elements From a Support Liquid by Engaging the Support Material With a Backing Material

Claim 1 is directed to a method for forming a planarizing medium for planarizing a microelectronic substrate. The method includes separating a planarizing medium material into discrete elements and disposing the discrete elements and a film support material on a support liquid with portions of the discrete elements spaced apart from

each other and projecting from the support material. The discrete elements are configured to engage the microelectronic substrate and remove material from the microelectronic substrate. The method further includes drawing the support material and the discrete elements from the support liquid by engaging the support material with a backing material and moving the backing material away from the support liquid.

2. The '108 Patent Discloses a Method for Forming an Article to Abrade a Workpiece Including Sinking Composites Into an Electroplating Solution and Forming a Metal Coating to Affix the Composites to a Backing

The '108 patent discloses a method for forming a metal bond abrasive article to abrade a workpiece. The method includes making ceramic abrasive composites by placing a slurry in a mold, drying the slurry, removing the slurry from the mold and separating the individual abrasive composites using a screen. (Col. 8, ll. 28-38.) The method further includes affixing the ceramic abrasive composites to a backing by sinking the composites in an electroplating solution and landing the composites on the backing. (Col. 10, ll. 38-41 and 57-59.) "After landing on the backing, metal is electroplated over the backing between the ceramic abrasive composites thereby forming a metal coating which affixes the ceramic abrasive composites to the backing." (Col. 10, ll. 59-62.) "In a preferred embodiment, a thin 'preshoot' coating is applied to the backing prior to the introduction of the ceramic abrasive composites." (Col. 10, ll. 42-44.)

3. The '929 Patent Discloses a Method of Forming an Abrasive Article for Grinding Glass

The '929 patent discloses a method of forming an abrasive article for grinding or polishing the surface of a glass workpiece. The method includes preparing an abrasive slurry and placing the slurry into a mold having cavities with the shape of the desired abrasive composites. (Col. 15, l. 65 – col. 16, l. 3.) The abrasive article may then be converted into a desired shape or form "by slitting, die cutting, or any other suitable means." (Col. 16, ll. 44-47.) The abrasive article can also "have an integrally molded backing, that is, the abrasive composites are directly bonded to a resin backing which is cast or molded onto the composites while the composites are still in the cavities of the mold." (Col. 16, ll. 48-53.)

4. Claim 1 Is Patentable Over the Applied References Because, *Inter Alia*, the Applied References Fail to Teach or Suggest All of the Features Recited in Claim 1

The MPEP requires the Examiner to set forth a *prima facie* case of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness. One element of a *prima facie* case requires that the prior art references teach or suggest all of the claim limitations. (MPEP at Section 2142.) For, *inter alia*, the reasons discussed below, the applied references fail to teach or suggest all of the features recited in claim 1.

The '108 and '929 patents fail to disclose or suggest, *inter alia*, a method for forming a planarizing medium including "disposing the discrete elements and a film support material on a support liquid" and "drawing the support material and the discrete elements from the support liquid by engaging the support material with a backing material," as recited by claim 1. For example, if one assumes that the abrasive composites and the electroplating solution of the '108 patent correspond in part to the discrete elements and the support liquid, respectively, recited in claim 1, the '108 patent fails to disclose "disposing the discrete elements and a film support material on a support liquid," as recited by claim 1. Instead, the '108 patent discloses disposing the abrasive composites in the electroplating solution. Furthermore, if one also assumes that the backing of the '108 patent corresponds in part to the support material of claim 1, the '108 patent does not disclose "drawing the support material and the discrete elements from the support liquid by engaging the support material with a backing material," as recited in claim 1. Instead, the '108 patent discloses forming a metal coating in the electroplating solution to affix the abrasive composites to the backing. Alternatively, if one assumes that the preshoot coating, the backing, the abrasive composites, and the electroplating solution of the '108 patent correspond in part to the film support material, the backing material, the discrete elements, and the support liquid, respectively, of claim 1, the '108 patent does not disclose "disposing the discrete elements and a film support material on a support liquid" or "drawing the support material and the discrete elements from the support liquid by engaging the support material with a backing material," as recited by claim 1. Instead, the '108 patent discloses disposing the preshoot coating and the abrasive composites in the electroplating solution and forming the preshoot coating over the

backing and a metal coating to affix the abrasive composites to the backing in the electroplating solution.

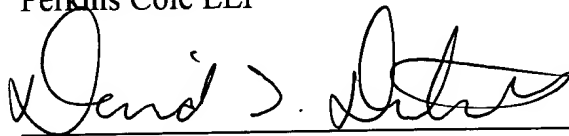
Furthermore, the '929 patent, as summarized above in Section A.3, fails to cure the above-noted deficiencies of the '108 patent as a reference adequate to support a rejection under 35 U.S.C. § 103(a). Accordingly, as agreed to by the Examiner, the applied references fail to support a *prima facie* case of obviousness under Section 103. Therefore, the Section 103(a) rejection should be withdrawn.

Claims 2-23 depend from claim 1 and are patentable over the applied references for the reasons discussed above and for the additional features of these dependent claims. Accordingly, the Section 103(a) rejection of these claims should be withdrawn.

C. Conclusion

In light of the foregoing remarks, all of the pending claims are in condition for allowance. Applicant, therefore, requests reconsideration of the application and an allowance of all pending claims. If the Examiner wishes to discuss the above-noted distinctions between the claims and the cited references, or any other distinctions, the Examiner is encouraged to contact David Dutcher by telephone. Additionally, if the Examiner notices any informalities in the claims, he is also encouraged to contact David Dutcher to expediently correct any such informalities.

Respectfully submitted,
Perkins Coie LLP



David T. Dutcher
Registration No. 51,638

DTD:ri

Enclosures:

Postcard

PTO-1083 (+ copy)

Associate Power of Attorney

PERKINS COIE LLP

P. O. Box 1247

Seattle, Washington 98111-1247

(206) 583-8888

FAX: (206) 583-8500